REMARKS

This paper is responsive to the February 28, 2008 Non-Final Office Action. Claims 1-17 were originally pending in this application. Claims 9-17 were previously canceled. Claims 4-7 are withdrawn herein in view of the February 12, 2008 telephonic election of species requirement. Claim 1 was previously amended and remains pending herein as previously presented. Claims 2–3 and 8 remain as originally filed. Thus, Claims 1–3 and 8 remain pending in this application and are presented herein for further consideration by the Examiner in view of the following remarks.

Affirmation of Election of Species

In telephonic conversation on February 12, 2008, Applicants were required to elect between six "patentably distinct species" identified by the Examiner. Applicants respectfully submit that the election requirement should not have been imposed; however in order to advance this application to allowance, Applicants affirm the election of Species I embodied by Figure 3 and defined in Claims 1-3 and 8. Although the election is made without traverse, Applicants reserve the right to reintroduce withdrawn Claims 4-7 upon allowance of generic Claim 1 or any other generic claim.

Response to Rejection of Claims 1, 2 and 8 under 35 USC § 102(b) as being anticipated by US Patent No. 6,015,139 to Weber

The Examiner rejects Claims 1, 2 and 8 under 35 USC § 102(b) as being anticipated by US Patent No. 6,015,139 to Weber. The Examiner asserts that Weber discloses every limitation of Claims 1, 2 and 8.

Applicants respectfully traverse the rejection of Claims 1, 2 and 8 as follows.

Weber does not disclose an anchor device capable of being used in a shear wall positioned on a structural support

In the Office Action, the Examiner states that "Weber disclose an anchor device 2 for capable of using in a shear wall that positioned on structural support."

Applicants respectfully submit that Weber does not disclose an anchor device capable of being used in a shear wall.

Weber describes his invention as "an anchor for removably mounting a guard rail system to a grating floor." As shown in the drawings of Weber, the anchor device 2 is mounted on top of a grating floor 30 with the upstanding sleeve 12 directed upward to receive a guard rail stanchion 14 (see Figure 6). Weber does not provide any suggestion whatsoever that the anchor device 2 is capable of being used in a shear wall. There is no relationship between the guard rail shown in Figure 6 and a shear wall in a building that would cause a person skilled in the art of building construction to consider the anchor device 2 for use in connection with the construction of a shear wall.

Weber does not disclose a compression post comprising a plate having a first surface mountable to a bottom surface of an end post of a shear wall

In the Office Action, the Examiner's stated basis for the rejection abruptly transitions to a "compression post comprising: a plate 10 having a first surface mountable to bottom surface of an end post of a shear wall."

Applicants respectfully submit that Weber does not disclose a compression post. Weber's anchor device 2 that receives the lower end of a guard rail stanchion 14 does not anticipate a compression post mounted to the lower end of an end post of a shear wall. Furthermore, the anchor device 2 in Weber does not have a first surface mountable to a bottom surface of an end post of a shear wall. The operation of the anchor device 2 in Weber depends on the locking members 5 that extend through the rectangular plate 4. Each locking member 5 has a post 22 that extends downwardly from the lower surface 20 of the plate 4. Each locking member 5 also has a transverse member 24 that extends horizontally from the post 22. The transverse member 24 engages the grating members 32 of the grating floor 30. The locking members 5 with the posts 22 and the transverse members 24 preclude any possibility of mounting the plate 4 to the lower end of an end post of a shear wall since the end post of a shear wall does not include grating members to engage the transverse members 24 of the locking

members 5. Even if one skilled in the art were to consider using the anchor device 2, the presence of the locking members 5 extending from the lower surface 20 of the plate 4 would prevent the plate from engaging the lower end of the end post to enable forces to be transferred from the end post to the plate.

If the Examiner is considering the removal of the locking members to provide access to the lower surface 20 of the plate 4, the Examiner is rendering the anchor device 2 unsuitable to be used for the purpose described in Weber. As clearly described in Weber, the locking members 5 comprising the posts 22 and transverse members 24 are required in order for the anchor device 2 to operate for its intended purpose. Applicants respectfully submit that any modification of Weber to remove the obstructing parts violates the examination standards set forth in MPEP 2143.01(V). In particular, the Examiner cannot rely on a proposed modification that would render the prior art unsatisfactory for its intended purpose. "If proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification." *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984).

Weber does not disclose a first surface having dimensions selected to conform to the bottom surface of an end post

In the Office Action, the Examiner states that "the plate [has] dimensions selected to conform to the bottom surface of the end post."

Applicants respectfully submit that Weber does not disclose any surface of the plate 4 of the Weber anchor device 2 having "dimensions selected to conform to the bottom surface of the end post." Rather, Weber does not disclose any dimensions of the rectangular plate 4. The locking members 5 appear to be spaced apart in at least one dimension to conform to the spacing between the grating members 32 as shown in Figure 2; however, no information can be derived from the text and drawings of Weber to determine the dimensions. Weber clearly does not provide any suggestion that the dimensions of the plate 4 of the anchor device 2 are selected to conform to the bottom

surface of an end post. Applicants respectfully submit that Weber does not provide any support whatsoever for the Examiner's statement that Weber discloses the plate having dimensions selected to conform to the bottom surface of the end post.

Weber does not disclose an extended portion having at least one dimension selected to fit through a hole in a mudsill of a shear wall

In the Office Action, the Examiner's states that "the extended portion" [12] has "at least one dimension selected to fit through a hole in a mudsill of the shear wall."

Applicants respectfully submit that Weber does not disclose any dimension of the upstanding sleeve 12 of the Weber anchor device 2 that is selected to fit through a hole in a mudsill of a shear wall. As discussed above, the dimensions of the anchor device 2 are not disclosed in Weber. Furthermore, Weber does not disclose any relationship between the anchor device 2 and an end post, a mudsill or any other portion of a shear wall. Thus, there is no basis whatsoever for the Examiner's statement that Weber discloses at least one dimension of the upstanding sleeve 12 "selected to fit through a hole in a mudsill of a shear wall."

Applicants further note although the upstanding sleeve 12 has a generally cylindrical appearance, the upstanding sleeve 12 includes a nut 17 that is welded onto the sleeve to threadably receive a bolt 40. See, Figures 1 and 2 and the description in column 3 at lines 52-56. Although the bolt 40 might be removable from the upstanding sleeve 12, the nut 17 is permanently attached to the sleeve 12. Accordingly, even if the upstanding sleeve 12 were to have a dimension (e.g., the outer diameter) that happened to have a size that fits through a hole in a mudsill, the welded nut 17 would preclude entry of the upstanding sleeve 12 into such a hole unless the hole were widened to accommodate the nut.

Weber does not disclose an extended portion having an exposed end displaced from the second surface by a length selected to conform to the thickness of the mudsill

In the Office Action, the Examiner's states that "the extended portion" has "an exposed end displaced from the second surface of the plate by a length selected to conform to a thickness of the mudsill such that when the compression post is mounted to the end post of the shear wall and the shear wall is mounted on a structural support, the exposed end of the extended portion rests on the structural support and forces applied to the compression post by the end post are communicated via the plate and the extended portion to the structural support."

Applicants respectfully submit that Weber does not disclose or suggest any particular length of the upstanding sleeve 12. More particularly, there is no suggestion whatsoever in Weber that the length of the upstanding sleeve 12 is selected on any basis related to the thickness of mudsill of a shear wall.

As defined in Claim 1, the length of the extended portion is selected to extend through the mudsill so that the compression forces applied to the end post are communicated via the end plate and the extended portion to the structural support. Weber does not suggest that the upstanding sleeve 12 communicates any compression forces. Rather, as best understood by Weber's description, the guard rail stanchion 14 fits inside the upstanding sleeve 12 such that any compression forces applied to the guard rail stanchion 14 would be communicated from the end of the stanchion directly to the plate 4 and thence to the underlying grating floor 30. The upstanding sleeve 12 appears to be intended to prevent horizontal or rotational movement of the guard rail stanchion 14 when pressure is applied to the side of the guard rail stanchion 14 by a person. Accordingly, the length of the upstanding sleeve 12 is likely selected to provide sufficient strength to withstand the horizontal or rotational forces applied to the upstanding sleeve 12 by the guardrail stanchion 14. This is an entirely different function than the transmission of compressive forces in the claimed invention. There is no suggestion that the length of the upstanding sleeve 14 selected to accommodate the

requirements for supporting a guard rail stanchion has any relationship whatsoever to a length selected to conform to the thickness of a mudsill of a shear wall.

Request for withdrawal of rejection of Claims 1, 2 and 8 based on Weber

As fully discussed in each of the preceding sections, Weber does not disclose or suggest the limitations in Claims 1, 2 and 8. The Examiner's statements that Weber discloses the elements with the claimed dimensions and structural relationships are not supported by Weber. Even with the benefit of unacceptable hindsight, one skilled in the art would not be able to utilize the anchor device 2 in Weber to form the compression post defined in Claims 1, 2 and 8.

Applicants respectfully submit that Claims 1, 2 and 8 are not anticipated by Weber. Applicants further submit that Claims 1, 2 and 8 are patentably distinguished over Weber. Applicants respectfully request the Examiner to withdraw the rejection of Claims 1, 2 and 8 based on Weber.

Request for withdrawal of rejection of Claim 3 based on Weber

Claim 3 depends from Claim 1 and further defines an embodiment of Claim 1 in which the extended portion is secured to the plate by at least one weld. In view of the patentability of Claim 1 over Weber, Applicants respectfully submit that Claim 3 is also patentably distinguished over Weber. Applicants respectfully request the Examiner to withdraw the rejection of Claim 3 based on Weber.

Summary of Response

Applicants have submitted the foregoing arguments in support of the patentability of Claims 1-3 and 8 over Weber. In view of the foregoing arguments, Applicants respectfully submit the Claims 1-3 and 8 are patentable over Weber and all other art of record. Applicants respectfully request the Examiner to withdraw all rejections and to allow Claims 1-3 and 8. Applicants further request the Examiner to restore Claims 4-7 and to allow Claims 4-7

Application No. : **10/773,757**
Filing Date : **February 6, 2004**
Final Office Action : **February 28, 2008**

Request for Interview

Applicants respectfully request the Examiner to contact Applicants' undersigned attorney of record to resolve any issues that may remain after the Examiner fully considers this response. If only minor issues remain to be resolved after entry of this response, the Examiner is cordially invited to call the undersigned attorney at 949-433-2849 to resolve any such issues or to allow the undersigned attorney to schedule a personal interview with the Examiner.

Respectfully submitted,

Dated: May 28, 2008

By: /Jerry Turner Sewell/
Jerry Turner Sewell
Registration No. 31,567
Customer No. 51476
949-433-2849